

REMARKS

By this amendment, claims 29-54 are pending, in which claims 29, 37, and 44 are currently amended. No new matter is introduced.

The Office Action mailed March 10, 2006 rejected claims 29-31, 33-38, 41-45, and 48-50 under 35 U.S.C. § 102(e) as anticipated by *Bandy et al.* (US 6,625,464 B1), claim 51 under 35 U.S.C. § 102(b) as anticipated by *DeLuca et al.* (US 5,870,030), claims 32, 39, 40, 46, 47, 51, and 52 as obvious under 35 U.S.C. § 103(a) based on *Bandy et al.* in view of *DeLuca et al.*, and claims 53 and 54 as obvious under 35 U.S.C. § 103(a) based on *Bandy et al.* in view of *DeLuca et al.* and further in view of *Dimitriadis et al.* (US 5,664,948). Also, the Office Action rejected claim 52 as obvious under 35 U.S.C. § 103(a) based on *DeLuca et al.* in view of *Bandy et al.*

To expedite prosecution, Applicants have amended independent claims 29, 37, and 44. Amended independent claim 29 recites “wherein the **advertisement capcode is selectively assigned to the paging unit on a temporal basis by a service provider.**” Independent claim 37 now recites “storing, in memory, an advertisement capcode for receiving an advertisement script, wherein **the advertisement capcode is temporarily assigned to a paging device by a service provider of the paging network** and is separate from a programmed capcode of the paging device.” Further, independent claim 44, as amended, recites “a memory configured to store an **advertisement capcode, temporarily assigned by a service provider of the paging network,** for receiving an advertisement script.”

By contrast, the *Bandy et al.* system discloses that the user assigns the capcodes, not a service provider. Also, those capcodes that are pre-programmed in the *Bandy et al.* system are permanent in nature. *Bandy et al.* emphasizes that the “giant” difference between the *Bandy et al.* system and prior paging technologies is **the ability to allow a consumer to program a**

receiver to receive messages from a sender, (col. 3, lines 32-46). *Bandy et al.* discloses, on col. 8, lines 32-54, the following (Emphasis Added):

The main software 117 may allow a user to enter a receiver frequency 118 in a preferred embodiment. Alternately, the software can allow the receiver to search for a frequency. Next, the software allows for the entering of a PI code 119. The PI code 119 may be user programmable or may be preselected. **Next, the user will have the ability to enter CAPCODES 120. Based upon the selection of the CAPCODES and the PI code, the main software 117 will filter messages 62, 63 according to the PI code and CAPCODE.** Next, the main software will store the messages having PI codes and CAPCODES which match the criteria programmed into the main software. **In addition to the PI codes and CAPCODES entered by a user, some PI codes and CAPCODES may also be pre-programmed into the software.** Some messages may trigger alarm functions 122 or system control 123 such as turning on a light bulb. Other system control 123 features may also be utilized. In addition to the main software, the user-programmable receiver will also likely have a real time clock 112, a system memory 113, a second microprocessor 114, CAPCODE memory 115 and message memory 116. Furthermore, the receiver 60 is likely to have an LCD display 103 and a keyboard 102.

The above disclosure indicates that capcodes entered into the receiver are either user programmed or merely pre-programmed. Those capcodes that are pre-programmed are contemplated as being **permanently entered** into the receiver. For example, *Bandy et al.* discloses, on col. 12, lines 26-34, the following (Emphasis added):

Businesses may buy user-programmable receivers which could have the **businesses CAPCODE permanently entered**. Accordingly, the user of that receiver would receive all messages sent out having that particular CAPCODE (i.e., a particular receiver would get all the advertisements from the XYZ Corp. **if that corresponding CAPCODE was permanently installed**).

Consistent with this passage, *Bandy et al.* is devoid of any disclosure indicating a possibility of temporal assignment.

Moreover, contrary to the Examiner's contention (Office Action, on page 4), *Bandy et al.* does not disclose the capability of un-assigning capcodes or expiring capcodes, further supporting Applicants' argument that the *Bandy et al.* system cannot temporarily assign capcodes. The Office Action, on page 4, cites to col. 7, line 65 – col. 8, line 57 and col. 9, lines

10-40. However, these cited passages fail to support the Office Action's contention; instead,

Bandy et al. merely discloses the following (Emphasis Added):

The users of the receivers shown in FIG. 3 are able to enter the CAPCODE assigned to the information generators 10 whose messages they wish to receive. The receiver 60 sorts and decodes from all groups and codes broadcast having the correct PI code. Messages are then filtered according to whether they have an information code which corresponds to any of the CAPCODES programmed into the receiver 60 by the receiver owner or any pre-programmed CAPCODE. This **precoding can be done by entering a CAPCODE or addressing code via a keypad incorporated with the receiver. Other methods of entering a CAPCODE could also be utilized such as selection with a touch screen or serial interface such as an RS232 port on a personal computer.** The receiver then allows the decoded messages to be displayed on a display, such as an LCD screen, pager or radio, or in commercial applications on billboards or road signs, or any other device designed to display electronic messages or audibly by text-to-voice conversion.

More specifically, FIG. 3 illustrates the inner workings of the user-programmable receiver 60. The particular receiver 60 shown is a typical FM receiver which would normally receive radio broadcasts between 88 and 108 Mhz. The receiver 60 will have a microprocessor 110 and a 57 Khz demodulator 111. As information is received by the radio receiver 60 the demodulator 111 and microprocessor 110 will work together to demodulate the information received by the receiver 60. Receiver software 61 will first search for a signal 65. Next, the RBDS data will be decoded 66. Next, the receiver 60 will filter the RBDS group 67 and format data 68. The formatted data 68 will be output as serial data 64. Additionally, the receiver software 61 may provide for receiver control 69. After receiving information in the radio receiver 60, the main software 117 may receive certain information.

The main software 117 may allow a user to enter a receiver frequency 118 in a preferred embodiment. Alternately, the software can allow the receiver to search for a frequency. Next, the software allows for the entering of a PI code 119. The PI code 119 may be user programmable or may be preselected. Next, **the user will have the ability to enter CAPCODES 120.** Based upon the selection of the CAPCODES and the PI code, the main software 117 will filter messages 62, 63 according to the PI code and CAPCODE. Next, the main software will store the messages having PI codes and CAPCODES which match the criteria programmed into the main software. In addition to the PI codes and CAPCODES entered by a user, some PI codes and CAPCODES may also be pre-programmed into the software. Some messages may trigger alarm functions 122 or system control 123 such as turning on a light bulb. Other system control 123 features may also be utilized. In addition to the main software, the user-programmable receiver will also likely have a real time clock 112, a system memory 113, a second microprocessor 114, CAPCODE memory 115 and message memory 116.

Furthermore, the receiver 60 is likely to have an LCD display 103 and a keyboard 102. [col. 7, line 65 – col. 8, line 57]

A user-programmable receiver in the preferred embodiment has a numeric keypad 102 as well as a liquid crystal display (LCD) 103. Furthermore, the receiver may, or may not, have an entertainment radio 110 having a tuner 107, a speaker 111, a display 108, and an antenna 108 as a part of a composite unit. The unit may also have a volume control 106. The keyboard 102, or other user-interface mechanism, may be utilized to enter information codes, such as PI codes and/or CAPCODES, for selectively choosing which groups a particular person would like to receive messages from. The user-programmable receiver 60 will have a storage memory to store a number of selected messages. A prototype has been built which will store at least 50 user selected messages. In addition to the storage of 50 messages, the presently preferred embodiment also stores 10 demand messages which can be accessed and displayed on display 103 by pushing numbers 0-9 on the keypad 102. The demand messages correspond at least in part to CAPCODES pre-programmed, possibly for local news, local weather, etc. These demand messages are likely to have sponsors where the message is displayed in conjunction with advertising. Furthermore, a group of 10 demand messages are stored that continuously scroll across display 103 together with sponsor's advertisements which are displayed when a user is not actively utilizing the user-programmable receiver 60. These scrolling messages can also be updated through the processing station 30. Furthermore, the time and date can also be displayed in the presently preferred embodiment. The memory storage device 116 of a presently preferred embodiment is 8K and uses a first in, last out storage mechanism such that upon receipt of the first 50 messages, the first message in is discarded. Other and/or additional storage mechanisms could be employed utilizing different storage techniques. Furthermore, a larger memory could be utilized depending on the specific capabilities chosen for a particular receiver. [col. 9, lines 10-40]

These passages simply describe that the *Bandy et al.* system can assign capcodes and the manner in which a user can select stored capcodes. It is not understood how the Examiner can surmise, based on this disclosure, that a teaching of “unassigning the advertisement capcode” exists (as in claim 34).

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim, as set forth in the claim, be disclosed in a prior art reference, based on the foregoing, it is clear that *Bandy et al.* fails to anticipate amended independent claims 29, 37, and 44. Accordingly, amended claims 29, 37, and 44, along with claims 30-36, 38-43, and 45-50, depending corresponding therefrom, are in condition for allowance.

Regarding the § 102 rejection of independent claim 51, independent claim 51 is directed to a “method of providing a paging service” and recites “**determining** which one or more paging units **is to receive the advertisement script based on a criteria.**” The Office Action, on page 2, applies *DeLuca et al.* to satisfy the above features, citing col. 7, line 43 – col. 8, line 39 and asserting that “Deluca teaches the service determining which pager is to receive the ads.” *DeLuca et al.*, however, fails to disclose any such criteria based determining step. Instead, *DeLuca et al.* teaches wirelessly transmitting a plurality of advertisements to a multiplicity of pagers. Specifically, *DeLuca et al.* discloses, within col. 7, line 43 – col. 8, line 39, the following (Emphasis Added):

FIG. 5 is a simplified pictorial representation of software elements 110, 112, 114, 118 and 120 and the display 78 within a selective call receiver 31 or one-way pager and of interactions among such software elements and with other elements external to the pager. An advertiser 100 places one or more advertisements, or ads, with a service provider 102 and pays to the service provider a monetary fee for such privilege. Concurrently, but independently, an information service 104 supplies to the service provider 102 information such as traffic or weather reports or stock market prices, and the service provider pays to the information provider a fee for such information. Typically, such information is regularly updated at frequent intervals soon after the contents therein becomes available to the information provider. One or more persons 106 place, without paying any fee, personal messages intended for the user 71 by telephoning the service provider. Collectively, the information supplied by the information provider and the personal messages are a first information type. The advertisements are a second information type. **The service provider wirelessly transmits ads, information, and messages, as the case may be, to the one-way pager 31 via RF signals.** The pager 31 intercepts RF signals through antenna 60. After receiving an RF signal and decoding an ad, the ad is stored in an advertiser's buffer 110 which is a data structure within RAM 88. After receiving an RF signal and decoding an update from an information service, the update is stored in an information service buffer 112 which is a data structure within RAM 88. After receiving an RF signal and decoding a personal message, the message is stored in a message buffer 114 which is a data structure within RAM 88.

Each ad transmitted to the pager has a preselected value assigned to it. **Preferably, the system controller transmits a plurality of ads to a multiplicity of pagers during off-peak hours.** Each of the plurality of ads is stored in the advertiser's buffer 110 along with the value assigned to the ad. Preferably, the value is expressed in units of money; but, alternatively, the value is expressed in

terms of a number of personal messages. Preferably, the preselected value assigned to an ad is directly proportional to the size, or length, of the ad. The preselected value of a particular ad is recovered by the user 71 by the user viewing, and therefore presumably reading, the particular ad. Advantageously, the user views the ads at a time convenient to the user, and not necessarily when the user is receiving a personal message as is detrimentally required in some prior art systems. After receiving a manual request from the user, the pager presents a message, such as an ad. The user views the ad on a display 78, preferably a graphical display, using means well known in the art. All ads have a unique identification number that is displayed with the ad. In order to ensure that the user actually reads, rather than merely scrolls through, the ad, the ad is displayed for a preselected period, proportional to the length and complexity of the ad, before the user is credited with the value assigned to the ad. Software elements stored within ROM 90 cause the microcomputer 80 to automatically increment a paging service account 118 after the ad appears on the display for the preselected period of time without further action by the user 71. The size of such increment is equal to the value assigned to the ad. The paging service account 118 is a data structure in RAM 88 and is a software-oriented designation for the debit/credit meter 77 which is hardware memory and is shown in FIG. 3.

As illustrated above, *DeLuca et al.* is silent on any teaching of the claimed method. Possibly in recognition of the reference's shortcomings, the Office Action fails to particularly point to any criteria from which the *DeLuca et al.* system bases its determination. Such a rejection contravenes 35 U.S.C. § 132, which requires the Director to "notify the applicant thereof, stating the reasons for such rejection." This section is violated if the rejection "is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection." *Chester v. Miller*, 906 F.2d 1574, 15 USPQ2d 1333 (Fed. Cir. 1990). This policy is captured in the Manual of Patent Examining Procedure (hereinafter MPEP) as well. For example, MPEP § 706 states that "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity." Furthermore, MPEP § 706.02(j) indicates that "[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given a fair opportunity to reply." Unfortunately, the Examiner's only discussion of the claim features is a

vague reference to a seemingly irrelevant passage (col. 7, line 43 – col. 8, line 39). Accordingly, independent claim 51 is in condition for allowance.

With respect to the obviousness rejection of claims 32, 39, 40, 46, 47, 51, and 52 based on the combination of *Bandy et al.* and *DeLuca et al.*, the addition of *DeLuca et al.* fails to cure the deficiencies of *Bandy et al.* *DeLuca et al.* is applied for a supposed teaching of “a method of transmitting advertising to pagers in which a pager account is credited for the advertising page.” Consequently, a *prima facie* case of obviousness has not been established.

Furthermore, the addition of *Dimitriadis et al.* fails to fill in the gaps of *DeLuca et al.* and *Bandy et al.* The Office Action, on page 12, applies *Dimitriadis et al.* for a supposed teaching of “replaying advertisement pages as voice signals.” As such, Applicants respectfully request withdrawal of the obviousness rejection, and urge the indication that dependent claims 53 and 54 be allowed.


As for the obviousness rejection of claim 52 based on *DeLuca et al.* in view of *Bandy et al.*, as explained the combination fails to disclose all the claim features of independent claim 51, from which claim 52 depends.

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 425-8508 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

DITTHAVONG & MORI, P.C.

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Date



Phouphanomketh Ditthavong
Attorney/Agent for Applicant(s)
Reg. No. 44658

10507 Braddock Road
Suite A
Fairfax, VA 22032
Tel. (703) 425-8508
Fax. (703) 425-8518